

R E M A R K S

This is a full and timely response to the Non-Final Office action mailed April 9, 2003, submitted concurrently with an Affidavit under 37 CFR 1.131 of prior invention to overcome a cited patent or publication. By this amendment, claim 1 was amended to incorporate the features of claim 12, and claim 12 was canceled without prejudice or disclaimer to its underlying subject matter. Claim 10 was amended to keep the consistency of each claim. No new matter was added. Accordingly, claim 1-11 are pending for the Examiner's reconsideration. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 103

"The Patent and Trademark Office (PTO) has the burden of showing a prima facie case of obviousness." In re Bell 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). "In determining the propriety of the Patent Office case for prima facie obviousness, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of

ordinary skill in the art to suggest making the proposed substitution or other modification." In re Taborsky, 183 USPQ 50, 55 (CCPA 1974). Moreover, prima facie obviousness of a claimed invention is established "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2001/0035856 A1 to Myers in view U.S. Patent Design 430,161 to Hovsepian.

This rejection is respectfully traversed for at least the following reasons.

Myers discloses a non-symmetrical hand-held computer pointing device. The apparatus of Myers includes strap 10 (fig.1). Hovsepian discloses an illustration of a hand supported and controlled mouse. Nevertheless, Myers and Hovsepian both fail to teach or fairly suggest, either individually or in combination, a symmetrical hand-held trackball computer pointing device, wherein the push button switches are positioned under the metacarpal region of the

hand. Further even if one were to combine the Myers reference with the Hovsepien design it would make Myers device inoperable, since Myers button mechanisms are placed to one side of the device, thereby making it incapable of being symmetrical. Further if one were to attempt to use Myers in the other hand the button mechanisms 30 and 32 would not be in position for the user to operate. Instead the button mechanisms would be in the palm portion of the user's hand, unaccessible to the user's finger tips. Additionally, in order to make Myers device symmetrical the button mechanisms would have to be moved to another location on the housing, thereby totally redesigning the original position of the each button. Myers device is shown to be used for one hand only, as well as using the phalanges portion of the hand, not the Metacarpal region as recited in the present invention.

Moreover, "hindsight is not proper criteria for resolving the issue of obviousness." In re Horn et al., 203 USPQ 969, 971 (CCPA 1979). **"The prior art must provide a motivation or reason for the worker in the art, without the benefit of the [applicants'] specification, to make the necessary changes in the reference device" (emphasis added).** Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353, (Bd.

Pat. App. & Int. 1984) (Examiner's rejection based on a rearrangement of parts lacked evidence showing motivation, and thus, the rejection was not sustained). See also MPEP 2144.04. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." MPEP 2143.03. Accord. MPEP 706.02(j).

For the reasons set forth above, each and every element of the invention is not found within Myers and Hovsepian, either individually or in combination. Therefore, Myers and Hovsepian do not render obvious Applicant's invention.

Myers and Hovsepian, either individually or in combination, do not teach or suggest the finished product of independent claim 1, and therefore, do not render obvious Applicant's invention. Further, dependent claims 2-11 are considered allowable for the same reasons discussed above with regard to claim 1, as well as the additional features they recite.

Enclosed herewith is a declaration under 37 C.F.R. 1.131 wherein the applicant establishes his date of conception of the invention earlier than the effective date of either U.S. Patent Application 2001/0035856 to Myers or

Design Patent Number 430,161 to Hovsepian, references cited by the Examiner, and under which the pending claims have been rejected. Applicant respectfully requests that, based on his declaration and the supporting evidence submitted herewith, that the Myers and Hovsepian references be withdrawn from consideration and that claims 1-11 rejected under U.S.C. 103 now be allowed and passed to issue.

Conclusion

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited and respectfully requests their allowance and that the application be passed to issue.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned agent at the below listed number.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Eugene Byrd', is written over the typed name and address.

Eugene Byrd
Agent for Applicant
Registration No. 47,361
Siemens Patent Services, L. C.
P. O. Box 2607
Fairfax, VA 22031
(540) 548-4404